

REMARKS / ARGUMENTS

The present application includes pending claims 1-31, all of which have been rejected. By this Amendment, claims 1, 5-7, 9, 11, 15-17, 19, 21, 25-27, and 29 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0072027, issued to Haines, et al. (hereinafter, Haines), in view of U.S. Patent No. 6,058,106, issued to Cudak, et al. (hereinafter, Cudak). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success

must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Haines and Cudak Does Not Render Claims 1-31 Unpatentable

The Applicant first turns to the rejection of claims 1-31 as being unpatentable over Haines in view of Cudak. The Applicant notes that the proposed combination of Haines and Cudak forms the basis for all of the pending rejections.

A. Independent Claims 1, 11, and 21

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Haines and Cudak does not disclose or suggest at least the limitation of "establishing at least one identifier associated with said legacy media peripheral, wherein said established at least one identifier is used to validate said legacy media peripheral for use at said first geographic location," as recited by the Applicant in independent claim 1. The Final Office Action states the following:

i. Haines teaches a method for secure access and communication of information in a distributed media network, the method comprising:

(1) detecting when a legacy media peripheral is connected to at least one of a PC and a media processing system on the distributed media network (see Figure 1 and page 2, paragraph 0019 of Haines);

(2) establishing at least one identifier associated with said legacy media peripheral (page 1, paragraph 0009 of Haines); and

(3) utilizing said established at least one identifier to facilitate communication of said legacy media peripheral over the distributed media network (page 1, paragraph 0008 of Haines).

ii. Although Haines teaches a method for secure access and communication of information in a distributed media network, Haines is silent on the capability of showing the legacy media peripheral. On the other hand, Cudak teaches this limitation in column 13, line 14 of Cudak.

See the Final Office Action at page 4. The Examiner relies on paragraph 0009 of Haines, which discloses the following:

In accordance with another aspect of the present invention, an article of manufacture includes a computer usable medium having computer readable code embodied therein. The computer readable code is configured to cause a processor to determine that a status change has occurred in the peripheral device, *combine a unique device identifier relevant to the peripheral device with the status change to form an electronic message* and transmit the electronic message from an embedded web server contained in the peripheral device across a firewall.

See Haines, page 1, paragraph 0009. At the above citation, Haines only discloses that a "unique device identifier" is combined with a status change to form an electronic message. Haines does not disclose or suggest the process of "establishing" an identifier associated with a legacy media peripheral. Even if we assume that Haines discloses establishing of identifier associated with the legacy media peripheral, the Examiner's argument is still deficient since the Haines does not disclose that the device identifier is used to validate the legacy media peripheral for use at the first geographic location, as recited in Applicant's claim 1. Cudak does not overcome the deficiencies of Haines.

The Applicant, therefore, maintains that the combination of Haines and Cudak does not disclose or suggest at least the limitation of "establishing at least one identifier associated with said legacy media peripheral, wherein said established at least one identifier is used to validate said legacy media peripheral for use at said first geographic location," as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not unpatentable over the combination of Haines and Cudak and is allowable. Independent claims 11 and 21 are similar in many

respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-10, 12-20 and 22-31

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Haines and Cudak has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20 and 22-31 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-10, 12-20 and 22-31.

In general, the Final Office Action makes various statements regarding claims 1-31 and the cited references, which statements are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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